

REMARKS

At the time of the First Office Action dated March 23, 2010, claims 14, 21, 28, and 35-53 were pending and rejected in this application.

CLAIMS 21 AND 42-47 ARE REJECTED UNDER THE SECOND PARAGRAPH OF 35 U.S.C. §

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The language that the Examiner has alleged is indefinite (i.e., "module") is no longer found within the claims. Thus, the Examiner's rejection is moot.

CLAIM 35 IS REJECTED UNDER THE SECOND PARAGRAPH OF 35 U.S.C. § 112

Applicants have amended claim 35 to recite "a request," and thus, proper antecedent basis has been supplied for this phrase. Thus, Applicants respectfully solicit withdrawal of the imposed rejection to the claims.

CLAIMS 14, 35, 38, AND 40-41 ARE REJECTED UNDER 35 U.S.C. § 101

On pages 3-5 of the First Office Action, the Examiner asserted that the claimed invention, as recited in claims 14, 35, 38, and 40-41, fails to meet the requirements of 35 U.S.C. § 101. This rejection is respectfully traversed.

At the outset, Applicants note that the Examiner has failed to allege or produce any substantial evidence to support a finding that the claimed invention is directed to one of the exceptions to statutory subject matter. See In re Bilski, ___ U.S. ___ (2010)("[t]he Court's

precedents provide three specific exceptions to § 101's broad patent-eligibility principles: 'laws of nature, physical phenomena, and abstract ideas'" citing Diamond v. Chakrabarty, 447 U. S. 303, 308 (1980)). Thus, the Examiner has failed to establish prima facie case.

Notwithstanding, Applicants note that independent claims 14 and 35 have been amended to recite that certain steps are performed via a network. Thus, independent claims 14 and 35 are tied to a machine (i.e., a network) and meet the "machine-or-transformation" test described by the Examiner. Thus, for the above-described reasons, Applicants respectfully solicit withdrawal of the imposed rejection of claims 14, 35, 38, and 40-41 under 35 U.S.C. § 101.

CLAIMS 21 AND 42-47 ARE REJECTED UNDER 35 U.S.C. § 101

On page 5 of the First Office Action, the Examiner asserted that the claimed invention, as recited in claims 21 and 42-47, fails to meet the requirements of 35 U.S.C. § 101. This rejection is respectfully traversed.

At the outset, Applicants note that the Examiner has failed to allege or produce any substantial evidence to support a finding that the claimed invention is directed to one of the exceptions to statutory subject matter. See Bilski v. Kappos, __ U.S. __ (2010)("[t]he Court's precedents provide three specific exceptions to § 101's broad patent-eligibility principles: 'laws of nature, physical phenomena, and abstract ideas'" citing Diamond v. Chakrabarty, 447 U. S. 303, 308 (1980)). Thus, the Examiner has failed to establish prima facie case.

Notwithstanding, Applicants note that independent claim 21 has been amended to recite a processor, which is a machine. Thus, for the above-described reasons, Applicants respectfully solicit withdrawal of the imposed rejection of claims 21 and 42-47 under 35 U.S.C. § 101.

**CLAIMS 14, 21, AND 28 ARE REJECTED UNDER 35 U.S.C. § 102 AS BEING
ANTICIPATED BY DAN ET AL., U.S. PATENT NO. 6,148,290 (HEREINAFTER DAN)**

On pages 5-12 of the First Office Action, the Examiner asserted that Dan discloses the invention corresponding to that claimed. This rejection is respectfully traversed.

The factual determination of anticipation under 35 U.S.C. § 102 requires the identical disclosure, either explicitly or inherently, of each element of a claimed invention in a single reference.¹ Moreover, the anticipating prior art reference must describe the recited invention with sufficient clarity and detail to establish that the claimed limitations existed in the prior art and that such existence would be recognized by one having ordinary skill in the art.²

"Both anticipation under § 102 and obviousness under § 103 are two-step inquiries. The first step in both analyses is a proper construction of the claims. ... The second step in the analyses requires a comparison of the properly construed claim to the prior art."³ During patent examination, the pending claims must be "given their broadest reasonable interpretation consistent with the specification,"⁴ and the broadest reasonable interpretation of the claims must

¹ In re Rijckaert, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); Perkin-Elmer Corp. v. Computervision Corp., 732 F.2d 888, 894, 221 USPQ 669, 673 (Fed. Cir. 1984).

² See In re Spada, 911 F.2d 705, 708, 15 USPQ 1655, 1657 (Fed. Cir. 1990); Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 678, 7 USPQ2d 1315, 1317 (Fed. Cir. 1988).

³ Medichem, S.A. v. Rolabo, S.L., 353 F.3d 928, 933 (Fed. Cir. 2003) (internal citations omitted).

⁴ In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000).

also be consistent with the interpretation that those skilled in the art would reach.⁵ Therefore, the Examiner must (i) identify the individual elements of the claims and properly construe these individual elements,⁶ and (ii) identify corresponding elements disclosed in the allegedly anticipating reference and compare these allegedly corresponding elements to the individual elements of the claims.⁷ This burden has not been met.

In the first full paragraph on page 6 of the First Office Action, the Examiner presented the following analysis:

creating said contract data comprising contract selection parameters for selecting at least one service contract out of said plurality of contracts (col. 7, lines 24-47; "This registration preferably includes storing of a service contract identification number, information regarding the service contract and the service contract itself.")

As claimed, the contract data comprises contract selection parameters, which given its broadest reasonable interpretation consistent with Applicants' specification refers to parameters (i.e., a plurality of parameters) used to select a contract. The only possible parameter described within the Examiner's cited passage that could conceivably used to select a contract is the service contract identification number. However, this service contract identification number regards a contract that has already been selected. As stated in column 7, lines 27-32, the contract is first created, and then registered. Thus, parameters identified by the Examiner are not used "for selecting at least one contract out of said plurality of contracts," as claimed. Instead, these parameters regarding a contract that has already been selected.

⁵ In re Cortright, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999).

⁶ See also, Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1567-68 (Fed. Cir. 1987) (In making a patentability determination, analysis must begin with the question, "what is the invention claimed?" since "[c]laim interpretation, . . . will normally control the remainder of the decisional process"); see Gechter v. Davidson, 116 F.3d 1454, 1460 (Fed. Cir. 1997) (requiring explicit claim construction as to any terms in dispute).

⁷ Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

In apparent belief that Dan does not identically disclose these features, the Examiner attempted to mitigate these limitations by asserted the following on page 7 of the First Office Action:

Furthermore, "contract selection parameters for selecting at least one service contract out of said plurality of contracts" is non-functional descriptive data.

The Examiner's additional analysis on pages 7-9 is attempt to bolster this finding. In short, Applicants' position is that the Examiner's finding and application of case law is misplaced.

In this regard, the Examiner is directed to the very first paragraph in M.P.E.P. § 2106.01, entitled "Computer-Related Nonstatutory Subject Matter," which states:

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works, and a compilation or mere arrangement of data.

As clearly evident by even a cursory review of Applicants' specification, the claimed "contract selection parameters" are functional descriptive material that impart functionality when employed as a computer component. In fact, a cursory review of the claim language itself (i.e., contract selection parameters for selecting at least one service contract out of said plurality of contracts) evidences that the contract selection parameters are functional in that they are used for selecting at least one service contract out of a plurality of contracts. Thus, the Examiner's assertion that the claimed "contract selection parameters" are non-functional descriptive material is plainly in error.

1 The Examiner's citation to In re Gulack and In re Ngai is also misplaced. Both In re Ngai
2 and the related case of In re Gulack involved issues regarding printed matter. However, the
3 claimed invention does not involve printed matter. In this regard, reference is made to the
4 following discussion within In re Lowry⁸ as to the differences between a data structure and
5 printed matter:

6 The printed matter cases “dealt with claims defining as the invention certain novel
7 arrangements of printed lines or characters, useful and intelligible only to the
8 human mind.” *In re Bernhart*, 417 F.2d 1395, 1399, 163 USPQ 611, 615 (CCPA
9 1969). The printed matter cases have no factual relevance where “the invention as
10 defined by the claims *requires* that the information be processed not by the mind
11 but by a machine, the computer.” *Id.* (emphasis in original). Lowry’s data
12 structures, which according to Lowry greatly facilitate data management by data
13 processing systems, are processed by a machine. Indeed, they are not accessible
14 other than through sophisticated software systems. The printed matter cases have
15 no factual relevance here.

16
17 Thus, as confirmed by the analysis within In re Lowry, the Examiner's reliance upon In re Ngai
18 and In re Gulack is misplaced.

19
20 Referring to the paragraph spanning pages 8 and 9 of the First Office Action, the
21 Examiner presented the following analysis:

22 The Examiner asserts that the type of data created can add little, if anything, to the claimed acts or
23 steps and thus does not serve as limitations on the claims to distinguish over the prior art. MPEP
24 2106IV b 1(b) indicates that “nonfunctional descriptive material” is material “that cannot exhibit
25 any functional interrelationship with the way the steps are performed”. Any differences related
26 merely to the meaning and information conveyed through data, which does not explicitly alter or
27 impact the steps is non-functional descriptive data.
28

⁸ 32 F. 3d 1579, 1583, 32 USPQ 2nd 1031, 1034 (Fed. Cir. 1994).

Applicants note that the section of the M.P.E.P. cited by the Examiner (i.e., § 2106(IV)(B)(I)(b)) is found in the Revision 4 of the Eighth edition of the M.P.E.P., which was issued in October of 2005. However, since the issuance of Revision 5 in August of 2006 through the current Revision 9 dated July of 2010, the language cited by the Examiner does not exist. As such, whatever guidance provide by this passage within Revision 4 of the Eighth edition of the M.P.E.P. no longer has any relevance.

The Examiner's failure to employ the correct version of the M.P.E.P. notwithstanding, the Examiner's allegation that the alleged "nonfunctional descriptive material" cannot exhibit any functional relationship with the way the steps are performed is clearly in error. The selected service contract (i.e., selected using the contract selection parameters) governs the provision of the service. Thus, the service received in the claimed "receiving the service according to said selection" has a functional relationship with the contract selection parameters.

Since Dan fails to teach the claimed "contract selection parameters," the Examiner has failed to establish that Dan identically discloses the claimed invention, as recited in claims 14, 21, and 28, within the meaning of 35 U.S.C. § 102. Applicants, therefore, respectfully solicit withdrawal of the imposed rejection of claims 14, 21, and 28 under 35 U.S.C. § 102 for anticipation based upon Dan.

CLAIMS 35-36, 40, 42, 46, 48, AND 52 ARE REJECTED UNDER 35 U.S.C. § 103 FOR

OBVIOUSNESS BASED UPON DAN

On pages 13-16 of the First Office Action, the Examiner concluded that one having ordinary skill in the art would have considered the claimed invention to be obvious in view of Dan. This rejection is respectfully traversed.

Claims 36, 40, 42, 46, 48, and 52 respectively depend from independent claims 14, 21, and 28, and Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claims 14, 21, and 28 under 35 U.S.C. § 102 for anticipation based upon Dan. Claim 35 includes similar limitations to those recited in claims 14, 21, and 28 (i.e., "contract selection parameters"). Applicants, therefore, respectfully submit that the imposed rejection of claims 35-36, 40, 42, 46, 48, and 52 under 35 U.S.C. § 103 for obviousness based upon Dan is not viable, and hence, Applicants solicit withdrawal thereof.

CLAIMS 37-39, 43-45, AND 49-50 ARE REJECTED UNDER 35 U.S.C. § 103 FOR

OBVIOUSNESS BASED UPON DAN IN VIEW OF "SOAP VERSION 1.2" (HEREINAFTER SOAP)

On pages 16 and 17 of the First Office Action, the Examiner concluded that one having ordinary skill in the art would have considered the claimed invention to be obvious in view of Dan and Soap. This rejection is respectfully traversed.

Claims 37-39, 43-45, and 49-50 respectively depend from independent claims 14, 21, and 28, and Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claims 14, 21, and 28 under 35 U.S.C. § 102 for anticipation based upon Dan. The

secondary reference to Soap does not cure the argued deficiencies of Dan. Accordingly, even if one having ordinary skill in the art did modify Dan in view of Soap, the proposed combination of references would not yield the claimed invention. Applicants, therefore, respectfully submit that the imposed rejection of claims 37-39, 43-45, and 49-50 under 35 U.S.C. § 103 for obviousness based upon Dan in view of Soap is not viable, and hence, Applicants solicit withdrawal thereof.

CLAIMS 41, 47, AND 52 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON DAN IN VIEW OF LAMB ET AL., U.S. PATENT PUBLICATION NO. 2005/0198111 (HEREINAFTER LAMB)

On page 18 of the First Office Action, the Examiner concluded that one having ordinary skill in the art would have considered the claimed invention to be obvious in view of Dan and Lamb. This rejection is respectfully traversed.

Claims 41, 47, and 52 respectively depend from independent claims 14, 21, and 28, and Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claims 14, 21, and 28 under 35 U.S.C. § 102 for anticipation based upon Dan. The secondary reference to Soap does not cure the argued deficiencies of Dan. Accordingly, even if one having ordinary skill in the art did modify Dan in view of Soap, the proposed combination of references would not yield the claimed invention. Applicants, therefore, respectfully submit that the imposed rejection of claims 37-39, 43-45, and 49-50 under 35 U.S.C. § 103 for obviousness based upon Dan in view of Soap is not viable, and hence, Applicants solicit withdrawal thereof.

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

Although Applicants believe that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction. (emphasis added)

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: July 23, 2010

Respectfully submitted,

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